BOX AF

512.20672PX1

Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 116

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	N. TANI et al
Serial No.:	737,880
Filed:	May 28, 1985
For:	ADSORBENT AND PROCESS FOR PREPARING THE SAME
Group:	116
Examiner:	W. Shine

REQUEST FOR RECONSIDERATION

Honorable Commissioner
of Patents and Trademarks
Washington, DC 20231

June 25, 1986

Sir:

In response to the Office Action dated March 25, 1986, applicants offer the following comments and arguments in support of the patentability of the claims now in the application, together with a Terminal Disclaimer.

Claims 16 to 20 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the prior invention as set forth in claim 14 of U.S. Patent No. 4,576,928, which patent is assigned to the assignee of the subject application. Also claims 16 through 19 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the prior invention as set forth in claim 15 of said

U.S. Patent No. 4,576,928. In order to overcome this rejection, applicants are submitting herewith a Terminal Disclaimer executed by Mr. Mabito Niino, the President of Kanegafuchi Kagaku Kabushiki Kaisha, the assignee of the subject application and the assignee of U.S. Patent No. 4,576,928. In view of this Terminal Disclaimer, it is respectfully submitted that these rejections, based on the doctrine of obviousness-type double patenting, have been overcome.

Claim 20 stands rejected under 35 USC 101 as claiming the same invention as that of claim 15 of prior U.S. Patent No. 4,576,928. In support of this rejection, it is urged that the cellulose gel of the present claim and the other limitations in the claim are the same limitations in applicants' parent patent claim. Applicants respectfully traverse this rejection. Initially, it is respectfully urged that in order to support a double patenting rejection under 35 USC 101, the claims in question must be substantially identical. Claim 20 of the present application depends upon claim 19 and claim 19 depends on claim 16. Claim 16 specifically calls for a water-insoluble porous hard gel with exclusion limit of 10^6 to 10^9 daltons. This limitation does not appear in claim 15 of U.S. Patent No. 4,576,928. Therefore, it is respectfully submitted that claim 20 of the subject application is not rejectable on the grounds of double patenting under 35 USC 101. The Examiner's attention is directed to a recent decision by the Court of Appeals, Federal

Circuit; namely, In re Kaplan et al, 229 USPQ 678, wherein the Court cited a passage from E. Stringham's Double Patenting at 207; i.e.:

> "One of the simplest, clearest, soundest and most essential principals of patent law, is that a later invention may be validly patented, altho [sic] dominated by an earlier patent, whether to the same or a different inventor. No one will seriously deny the correctness of this statement in principal. But it is increasingly lost sight of when an actual case must be decided."

In view of the accompanying Terminal Disclaimer and the above comments, favorable reconsideration and allowance of all the claims now in the application are respectfully requested.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees to account 01-2135 (512.20672PX1) and please credit any excess fees to this deposit account.

Respectfully submitted,

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Attachment: Terminal Disclaimer